

REMARKS

Claims 3-9, 11-13, 16-21, 24, 26, 28-35, 37, 39 and 41-68 were pending and presented for examination and in this application. In an Office Action dated December 15, 2008, claims 3-9, 11-13, 16-21, 24, 26, 28-35, 37, 39 and 41-68 were rejected. Applicants thank the Examiner for examination of the claims pending in this application and addresses the Examiner's comments below. Based on the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

Finality of Next Action is Precluded – Unaddressed Claim Limitations

On page 5 of the Office Action, the Examiner has rejected claim 18 based on the rejections of claims 3-9, 11-13, 16, and 17. However, claim 18 includes subject matter not included in claims 3-9, 11-13, 16, and 17. E.g., none of these claims recite the limitation: “adding an electronic representation of the **annotation** to the electronically stored collection of information.” Thus, the Examiner **has not addressed** at least one limitation present in claim 18. Accordingly, Applicants submit that a next Office Action rejecting independent claim 18 cannot properly be made final, since this limitation of claim 18 will be newly addressed therein. *See* MPEP § 706.07(a).

Response to Rejection Under 35 U.S.C. § 102(b)

In the sixth paragraph of the Office Action, the Examiner rejects claims 3-9, 11-13, 16-21, 24, 26, and 28-32 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 7,165,268 (“Moore”). This rejection now is traversed.

Independent claim 3, which was not amended recites, *inter alia*, a method of composing a collection of information comprising:

- receiving, at a multi-function peripheral, a plurality of paper documents in an order;
- determining, by the multi-function peripheral, the order of the plurality of paper documents;
- responsive to the order of the plurality of paper documents, selecting, by the multi-function peripheral, at least one action from a group of actions consisting of:
 - creating a new collection;
 - modifying a collection; and
 - adding an electronic representation of a document to a collection; and
- performing, by the multi-function peripheral, the selected at least one action based on the order of the plurality of paper documents.

These aspects of the claimed invention are not disclosed or suggested by Moore. Specifically, Moore does not disclose or suggest “determining, by the multi-function peripheral, the **order of the plurality of paper documents.**” Moore discloses a method in which a sender creates an encrypted content message and an encrypted authentication message. The sender permits an authorized recipient to obtain a tangible medium containing the content message and authentication message. The recipient decrypts the authentication message and sends a reply created based on the authentication message to the sender. Upon determining that the reply is valid, the sender allows the recipient to obtain a content decryption key, which the recipient is able to use to decrypt the content message. *See*, Moore, col. 2, line 42 through col. 8, line 2.

In the rejection of claim 3, the Examiner cites column 10, lines 10-35 in an attempt to show that Moore discloses “determining, by the multi-function peripheral, the order of the plurality of paper documents.” This section of Moore merely discloses that a content

message is broken up into a plurality of blocks, each separately encrypted by the sender. The recipient decrypts the blocks in a sequential order. In column 8, lines 16-18, Moore discloses that the content message blocks are on the tangible medium obtained by the recipient.

Thus, at best Moore discloses determining the sequential **order** *of encrypted content message blocks on a piece of paper*. In contrast, the claimed invention determines an **order of a plurality of paper documents**. Moore at no point discloses the recipient determining the order of a plurality of paper documents received. Thus, Moore does not disclose the determining limitation of claim 3.

Given that there is no hint, mention, or suggestion in Moore of determining an order of a plurality of paper documents, it therefore follows that Moore does not disclose at least two other limitations of claim 3: “responsive to the order of the plurality of paper documents, selecting, by the multi-function peripheral, at least one action from a group of actions” and “performing, by the multi-function peripheral, the selected at least one action based on the order of the plurality of paper documents.”

Accordingly, Applicants submit that claim 3 is patentably distinguishable over the cited reference. Claim 4 includes similar limitations as claim 3 and is therefore patentably distinguishable over the cited reference for at least the same reasons. Applicants respectfully request that the Examiner withdraw the rejection of claims 3 and 4.

Dependent claims 5-9, 11-13, 16, 17, and 68 incorporate the limitations of their respective base claim. Applicants submit that claims 5-9, 11-13, 16, 17, and 68 are allowable

for at least the reasons described above, in addition to the further patentable limitations recited therein.

Independent claim 18, which was not amended recites, *inter alia*, a method for adding an annotation to an electronically stored collection of information, comprising

- receiving a piece of paper comprising a collection identifier and the annotation, the collection identifier identifying the electronically stored collection of information;
- reading the collection identifier and the annotation from the piece of paper;
- accessing the electronically stored collection of information identified by the collection identifier; and
- adding an electronic representation of the annotation to the electronically stored collection of information.

These aspects of the claimed invention are not disclosed or suggested by Moore, nor does the Examiner allege that they are. As noted above, the Examiner has not addressed this claim directly, which includes subject matter not included in claims 3-9, 11-13, 16, and 17.

Moore does not disclose or suggest “accessing the electronically stored collection of information **identified by the collection identifier**” nor “adding an electronic representation of the annotation **to the electronically stored collection of information.**”

In col. 14, lines 47-58, Moore discloses that an encrypted authentication message and encrypted content message may be fixed to paper medium using characters that may be scanned. At best, Moore discloses being able to scan the messages from a paper medium. However, Moore does not disclose that a collection identifier is also read from the paper medium and that an electronic representation of the messages is added to an **electronically stored collection identified by the collection identifier.**

Thus, Moore does not disclose the accessing and adding limitations of claim 18. Accordingly, Applicants submit that claim 18 is patentably distinguishable over the cited

reference. Applicants respectfully request that the Examiner withdraw the rejection of claim 18.

Dependent claims 19-21, 24, 26, and 28-32 incorporate the limitations of their respective base claim. Applicants submit that claims 19-21, 24, 26, and 28-32 are allowable for at least the reasons described above, in addition to the further patentable limitations recited therein.

Response to Rejection Under 35 U.S.C. § 103(a)

In the seventh paragraphs of the Office Action, Examiner rejects claims 33-35, 37, 39, and 41-67 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,870,552 (“Dozier”), in view of U.S. Patent No. 5,280,609 (“MacPhail”) and further in view of U.S. Patent No. 5,710,874 (“Bergen”). This rejection is now traversed.

With regards to claim 33, on page 31 of the Office Action the Examiner has stated that the arguments filed on October 28, 2008 are not persuasive. The Examiner explains in the Response to Arguments section of the office Action (p. 31) that Applicants’ arguments are not persuasive because:

applicant states that claim 33 recites a method providing a mechanism for enabling a first access level for users having a first machine-readable indicium and a second, different access level for users having a second machine-readable indicium. The Examiner does not agree with applicant's statement that the above-mentioned language is recited in the claim.

However, the Examiner’s comments are not responsive to Applicants arguments in the Amendment dated October 28, 2008. The statements quoted by the Examiner were made in a *prior* response (filed April 25, 2008). It appears that the Examiner merely has copied

and pasted from his previous rejection in the Office Action dated August 7, 2008 (p. 41), to which the October 28, 2008 Amendment was responsive, but has not addressed the arguments presented in the response filed on October 28, 2008.

Since the Examiner has not addressed the arguments for claim 33 in this rejection, Applicant has no choice but to restate the arguments here.

Independent claim 33, which was not amended recites, *inter alia*, a method of providing differentiated access to a collection of information, the method comprising:

- generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels, wherein the first access level identifies a first level of access privileges;
- generating a second pointer to the collection, the second pointer specifying a second access level different from the first access level, wherein the second access level identifies a second level of access privileges;
- generating a machine-readable indicium representing at least one of the first pointer and the second pointer; and
- outputting a document including the machine-readable indicium.

These aspects of the claimed invention are not disclosed or suggested by Dozier. Dozier discloses a development platform technology for publishing hypermedia documents across wide area networks. *See*, Dozier, col. 3, lines 41-43. Dozier does not disclose or suggest “generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels, wherein the first access level identifies a first level of access privileges,” nor does the Examiner make this assertion. The Examiner applied Dozier to allegedly disclose a method of providing differentiated access to a collection of information.

MacPhail does not remedy the deficiencies of Dozier. MacPhail discloses a document management system for controlling the creation, retrieval, editing, and distribution

of documents within an information processing system. The document manager system enables a user to create a folder and file it into a library. Documents filed with the folder and documents presently existing in the library can entered into the folder. *See*, MacPhail, col. 2, lines 56-66. Thus, MacPhail does not disclose or suggest “generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels, wherein the first access level identifies a first level of access privileges.”

In the rejection of claim 33, the Examiner cites column 4, lines 5-65 in an attempt to show that MacPhail discloses “generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels, wherein the first access level identifies a first level of access privileges.” In column 3, lines 5-65, MacPhail discloses that each document stored in the library includes multiple objects. One of the objects is a document relation object that describes the logical connection between the document and other documents. If the document is a folder, the document relation object includes a pointer or LADN entry for each document in the folder.

Thus, the examiner attempts to equate a pointer to a document in a folder to the claimed “first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels.” This correspondence is incorrect. The pointer disclosed by MacPhail is simply specifying the location of a document that is part of the folder. However, in the claimed invention, the pointer itself specifies an **access level** from a plurality of access levels. There is no hint, mention, or suggestion in MacPhail of a pointer that specifies an access level from a plurality of access levels, as is claimed.

Bergen does not remedy the deficiencies of Dozier and MacPhail. Bergen discloses a system that includes an image processing device for scanning a substrate that includes machine readable code. *See*, Bergen, Abstract. Bergen does not disclose “generating a first pointer to a collection of information, the first pointer further specifying a first access level from a plurality of access levels, wherein the first access level identifies a first level of access privileges.”

Thus, the cited references fail to show all of the claimed elements and thus the Examiner has not met his burden in establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Claim 33 is patentably distinguishable over the cited references.

Independent claims 41, 56, 57, 59, 62, 63, and 64 include similar limitations to claim 33. All arguments advanced above with respect to claim 33 also apply to claims 41, 56, 57, 59, 62, 63, and 64. Applicants submit that claims 33, 41, 56, 57, 59, 62, 63, and 64 are patentably distinguishable over the cited reference for at least the reasons described above, in addition to the additional patentably distinguishable features recited therein. Applicants respectfully request that the Examiner withdraw the rejection of claims 33, 41, 56, 57, 59, 62, 63, and 64.

Dependent claims 34, 35, 37, 39, 42-55, 58, 60, 61, and 65-67 incorporate the limitations of their respective base claim. Applicants submit that claims 34, 35, 37, 39, 42-55, 58, 60, 61, and 65-67 are allowable for at least the reasons described above, in addition to the further patentable limitations recited therein.

Conclusion

In sum, Applicants respectfully submit that claims 3-9, 11-13, 16-21, 24, 26, 28-35, 37, 39, and 41-68, as presented herein, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,

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